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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			JIANG, SHAOJIA A	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 07/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/941,589

Applicant(s)

PICARD-LESBOUEYRIES ET AL.

Examiner

Shaojia A Jiang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/2/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 2, 2004 has been entered.

This Office Action is a response to Applicant's request for continued examination (RCE) filed April 2, 2004, and amendment and response to the Final Office Action (mailed December 3, 2003), April 2, 2004 wherein claims 1-2 and 4-29 have been amended.

Currently, claims 1-2 and 4-29 are pending in this application.

Claims 1-2 and 4-29 as amended now will be examined on the merits herein.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2 and 4-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,733,765.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent is drawn to a composition comprising the same surfactant system in an aqueous medium comprising at least 10% by weight water soluble soaps and wherein said surfactant system exhibits at least one paracrystalline phase selected from the group consisting of direct hexagonal phase, cubic phase or mixtures having the same stability at 30-45⁰C for a foaming cosmetic cream. Note that the specification also discloses that the composition of the patent also comprises active agents herein as the instantly claimed (see col.10 line 20-31).

The claims of the instant application are drawn to the same surfactant system in an aqueous medium used with an active agent herein in a stable foaming composition.

Thus, the composition in the patent and the composition in the instant application comprising the same surfactant system in an aqueous medium having the same foaming properties are seen to substantially overlap.

Thus, the instant claims 1-2 and 4-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,733,765.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 and 4-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahms et al. (5,911,981, of record) and Erilli et al. (5,629,279, of record) and Ribier et al. (5,601,833 of record).

Dahms et al. discloses a stable foaming composition in an aqueous medium comprising a surfactant system generating a large volume of a stable foam therein containing paracrystallin phase or lamellar phase (see col.11 lines 3-24) such as direct hexagonal phase (Fig.2, 7, 9-10 and col.3 lines 61 to col.4 line 30), water-soluble soaps for cleaning skin or hair including removing a greasy soil from skin or hair such as shampoo or shower gel (see also abstract, col.1 lines 5-16, col.2 lines 8-34, fig. 2, col.3 lines 6-13 and 63-66, col.10 lines 34-35, 45, 54-55, col.13 lines 35-36 and Table 1-5 at col.11-15). Dahms et al. also teaches that one of the applications of the composition therein is shaving creams (see col.2 lines 24-6 and col.4 lines 37-38). Dahms et al. further discloses that the surfactant system comprises one water-insoluble surfactant in about 75% weight (nonionic or amphoteric) and water soluble anionic surfactants, C8-C12 acyl lactylate (0.1-25% weight) and a sulfated anionic surfactant (see the structural formula at col. 3 lines 40-49, col.4 line 64, col.8 lines 55-60, and claims 1-16).

Erilli et al. discloses a stable foaming composition in an aqueous medium for cleaning skin comprising a surfactant system which comprises water-insoluble surfactants (nonionic or amphoteric) and water soluble surfactants (10-30% or 1-10% weight) within the instant claims. Erilli et al. also discloses that the active agents therein range from 0.5% to 5%. See abstract, col.2-8 and claims 1-9.

The prior art does not expressly disclose that the employment of an active agent here in combination with a surfactant system herein in a composition and a method for cleaning greasy skin and or acne skin. The prior art does also not expressly disclose that the surfactant system is stable at up to 45°C. The prior art does also not expressly disclose the particular range of amounts of surfactants herein in the composition.

Ribier et al. discloses that a composition for the simultaneous treatment of skin such as protecting and nourishing including removing fatty substance in the skin comprises water-soluble surfactants, water-insoluble surfactants, and active agents such as anti-oxygenated-free-radical agents and vitamins. See abstract, col.1 line22, col3 lines 50-51, col.4 lines 10-22, col.7 and claims 1-17.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to employ a surfactant system herein in combination with an active agent here in a composition and a method for cleaning greasy skin and/or acne skin, and to optimize the surfactant system to be stable at up to 45°C, and to optimize the particular range of amounts of surfactants herein in the composition.

One having ordinary skill in the art at the time the invention was made would have been motivated to employ a surfactant system herein in combination with an active

agent here in a composition and a method for cleaning greasy skin and or acne skin since adding active agents herein such as salicylic acid to a foaming composition for cleaning skin is well known in the art. Moreover, the surfactant systems in the compositions of Dahms and Erilli are known to be useful in cleaning greasy skin. Therefore, one of ordinary skill in the art would have reasonably expected that combining the surfactant system of Dahms or Erilli and an active agent known useful for the same purpose (i.e., cleaning or treating skin) in a composition to be administered would improve the therapeutic effect for cleaning/treating skin. Further, the teachings of Ribier et al. provide the motivation for the combination herein.

Additionally, although the prior art does not expressly teach that the surfactant system would be stable at up to 45⁰C, a skilled artisan would clearly recognize that the thermal stability is merely an inherent property of the composition therein. Since it is well settled that recitation of an inherent property of a composition will not further limit claims drawn to a composition.

Moreover, one of ordinary skill in the art would have been motivated to optimize the surfactant system to be stable at up to 45⁰C, and to optimize the particular range of amounts of surfactants herein in the composition because it is within the skill in the art to select optimal parameters, optimizing amounts of ingredients and measuring their inherent properties, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

Thus the claimed invention as a whole is clearly prima facie obvious over the combined teachings of the prior art.

Applicant's remarks filed on April 12, 2003 with respect to this rejection made under 35 U.S.C. 103(a) of record stated in the previous Office Action (December 3, 2003) have been fully considered but are not deemed persuasive as to the nonobviousness of the claimed invention over the prior art for the following reasons.

Applicant assertion that "Dahms is completely different from the claimed invention, which is directed to a cream composition", is not found convincing. Dahms et al. clearly discloses the composition having stable **foaming** properties as the instantly claimed and comprising the same or substantial similar surfactant system comprises a surfactant system generating a large volume of a stable foam therein containing paracrystallin phase or lamellar phase such as direct hexagonal phase, one water-insoluble surfactant in about 75% weight (nonionic or amphoteric) and water soluble anionic surfactants, acyl lactylate (0.1-25% weight) and a sulfated anionic surfactant. Dahms et al. also teaches that one of the applications of the composition therein is shaving creams.

It is noted that the instant claim is also drawn to a foaming composition for treating greasy skin. Regarding the recitation "paracrystalline phase", the attention is directed to Applicant's own definition in the specification herein (see page 6 line 6-7 of the specification herein) "the paracrystalline phase formed (or **liquid crystal**).." (emphasis added), and "one paracyrstalline phase of direct hexagonal or cubic type appears.." (see page 6 line 1-2 of the specification herein), "the terms "**lamellar phase**", "direct hexagonal phase", and "cubic phase" have the meanings usually given to them by those skilled in the art" (emphasis added, see page 7 line 10-12 of the specification

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herein). Thus, the instant paracrystalline phase clearly reads on the liquid crystalline structures such as such as direct hexagonal phase and the instant paracrystalline phase itself differs not from the liquid crystalline structures disclosed by Dahms et al.

The reference of Cook provided by Applicant clearly teaches that "Foams are created by dispersing air or a gas in a surfactant containing liquid" and "gas bubbles dispersed in a liquid are stabilized in the same was as emulsion, i.e., by formation of surfactant layers at the gas-liquid interface" (see the last paragraph of page 1 to 1st paragraph of page 2) and also teaches various foam structures including hexagonal foams (see Fig 2 and 4). Thus, a foaming composition is known to generate gas bubbles. The instant paracrystalline phase of direct hexagonal is also generated by formation of surfactant layers at the gas-liquid interface according to the specification herein. Hence, the instant paracrystalline phase of direct hexagonal type itself is not different from those liquid crystalline structures disclosed by Dahms et al. and Cook, and have the meanings usually given to them by those skilled in the art as Applicant admits in the specification.

Applicant again further argues that Erilli and Ribier do not compensate for Dahms' deficiencies. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F.2d 413, 208 SPQ 871 (CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). See MPEP 2145. In the instant case, Erilli and Ribier have been cited by the examiner primarily for its teaching that water-insoluble surfactants (nonionic or amphoteric) and water soluble surfactants (10-30% or 1-10% weight) within

the instant claims and the active agents therein range from 0.5% to 5%, such as anti-oxygenated-free-radical agents and vitamins, are known in the art.

Additionally, although the prior art does not expressly teach that the surfactant system would be stable at up to 45°C, a skilled artisan would clearly recognize that the thermal stability is merely an inherent property of the composition therein since Dahms et al. discloses a stable foaming composition in an aqueous medium. It is well settled that recitation of an inherent property of a composition will not further limit claims drawn to a composition.

Moreover, one of ordinary skill in the art would have been motivated to optimize the surfactant system to be stable at up to 45°C, and to optimize the particular range of amounts of surfactants herein in the composition because it is within the skill in the art to select optimal parameters, optimizing amounts of ingredients and measuring their inherent properties, in a composition in order to achieve a beneficial effect. See *In re Boesch*, 205 USPQ 215 (CCPA 1980).

Again, as discussed in the previous Office Action, note that the declaration of Odile Aubrun, submitted December 2, 2002 under 37 CFR 1.132, has been fully considered but not found persuasive as discussed below. Applicant asserts that in Aubrun declaration "U.S. Patent no. 5,911,981 did not have a hexagonal phase". As discussed above, that Dahms composition clearly contains a hexagonal phase, see Dahms' Figures for example. Moreover, Applicant's experiment results in Aubrun's declaration are not seen to provide clear and convincing evidence in support of Aubrun's statements or conclusion in the declaration that U.S. Patent no. 5,911,981 did

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not have a hexagonal phase. First, it is noted that both in the specification and the declaration provide no evidence showing the instant composition processing paracrystallin phase or lamellar phase such as direct hexagonal phase. Secondly, the experiment results and Exhibit 1-3 are not seen to demonstrate side-by-side comparison, i.e., providing comparative figures at 45⁰C of lamellar phase, as same as Dahms' Figures in the patent, in support of nonobviousness for the instant claimed invention over the prior art.

Further, Applicant generated data in Aubrun's declaration, proffered to obviate prior art teachings, lack the probative force accorded data generated by independent, disinterested parties. It is well settled patent law "that it is not a difficult matter to carry out a process in such a fashion that it will not be successful and, therefore, the failures of experiments who have no interest in succeeding should not be accorded great weigh". See *In re Michalek*, 74 USPQ 108, at 109 citing *Bullard Company et al. Coe*, 147 F. 2d. 568, 64 USPQ 359.

Therefore, the declaration is ineffective and insufficient to rebut the prima facie case herein.

Furthermore, as discussed in the previous Office Action, Applicant's data shown in the Examples 1-2 of the specification at pages 26-33 herein have been fully considered with respect to the nonobviousness and/or unexpected results of the claimed invention over the prior art but are not deemed persuasive for the reasons below. Examples herein provide no clear and convincing evidence of nonobviousness or unexpected results over the cited prior art since there is no comparison to the same

present. Moreover, Examples herein merely demonstrate two particular compositions within the instant claims. Thus, the evidence in the examples is also not commensurate in scope with the claimed invention and does not demonstrate criticality of a claimed range of the ingredients in the claimed compositions. See MPEP § 716.02(d).

Therefore, the evidence presented in specification herein is also not seen to support the nonobviousness of the instant claimed invention over the prior art.

Therefore, motivation to combine the teachings of the prior art cited herein to make the present invention is seen. The claimed invention is clearly obvious in view of the prior art.

For the above stated reasons, said claims are properly rejected under 35 U.S.C. 103(a). Therefore, said rejection is adhered to.

In view of the rejections to the pending claims set forth above, no claims are allowed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (571)272-0627. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703.872.9306.

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June 21, 2004